

REMARKS

Applicants submit that by the present Amendment and Remarks, this Application is placed in clear condition for immediate allowance. At the very least, the present Amendment places the Application in better condition for Appeal by reducing the number of issues, because the present Amendment only cancels certain claims. In short, by the present Amendment, claims 4, 6, 7, 17 and 19 have been cancelled. Therefore, the present Amendment does not generate any new matter issue or any new issue for that matter. Accordingly, entry of the present Amendment and Remarks and favorable consideration are solicited pursuant to the provisions of 37 C.F.R. § 1.116.

Claims 2, 3, 8 through 10, 12 through 14, 16, 18, 20 and 21 are pending in this Application. As previously noted, claims 4, 6, 7, 17 and 19 have been cancelled.

Claims 2, 3, 8 through 10, 12 through 14, 18, 20 and 21 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Christopoulos.

In the statement of the rejection, the Examiner referred to portions of Christopoulos, asserting the disclosure of an image data transmission apparatus and image transmitting method corresponding to those claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). When imposing a rejection under 35 U.S.C. § 102, the Examiner is required to

specifically identify wherein an applied reference identically discloses each and every feature of a claimed invention, particularly when such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has not been discharged. Indeed, there are fundamental differences between the claimed inventions and the apparatus and method disclosed by Christopoulos that scotch the factual determination that Christopoulos disclose an apparatus and method identically corresponding to those claimed.

Specifically, as to claims 2, 3, 12, 13, 18 and 20, and the claims dependent thereon, Applicants note that the “bit rate” disclosed by Christopoulos does **not** indicate hardware performance of the **network itself**. Rather, the “bit rate” disclosed by Christopoulos indicates the output rate to be achieved in “transcoding”. That concept is entirely different from the “transmission rate” of the claimed invention.

The above argued difference between the claimed inventions and Christopoulos is not the only difference. Indeed, Christopoulos neither discloses nor suggests the notion of controlling the amount of image data to be transmitted in accordance with the measured value or the value obtained by measuring the transmission rate of previously transmitted data.

Claims 14 and 21.

Although claims 14 and 21 are included in the rejection, it is apparent that the Examiner did not separately address claims 14 and 21 as the Examiner addressed the other independent claims. Applicants, therefore, assume that claims 14 and 21 were inadvertently included in the rejection. At any rate, in an abundance of caution, Applicants traverse the imposed rejection of

claims 14 and 21 on the basis that the Examiner did not establish a *prima facie* basis to deny patentability to claims 14 and 21 under 35 U.S.C. § 102. Specifically, the Examiner did not point out wherein the only applied reference to Christopoulos discloses or suggests an apparatus corresponding to that defined in claim 14 or a method defined in claim 21. *In re Rijckaert, supra; Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., supra.* As the Examiner did not establish a *prima facie* basis to deny patentability to claims 14 and 21, Applicants are under no obligation to even submit an argument. *In re Deuel, 51 F.3d 1552, 34 USPQ2d 1210 (Fed. Cir. 1995); In re Rijckaert, supra; In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992); In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).*

The above argued differences between the claimed inventions and Christopoulos undermine the factual determination that Christopoulos discloses an image data transmission apparatus or an image receiving method identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).* Applicants, therefore, submit that the imposed rejection of claims 2, 3, 8 through 10, 12 through 14, 18, 20 and 21 under 35 U.S.C. § 102 for lack of novelty as evidenced by Christopoulos is not factually viable and, hence, solicit withdrawal thereof.

Claims 4, 6 and 7 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Christopoulos in view of Enari.

This rejection is traversed. Indeed, this rejection has been rendered moot by canceling claims 4, 6 and 7. Accordingly, withdrawal of the rejection of claims 4, 6 and 7 under 35 U.S.C. § 103 for obviousness predicated upon Christopoulos in view of Enari is solicited.

Claim 9 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Christopoulos in view of Ejiri.

This rejection is traversed. Specifically, claim 9 depends from independent claim 2. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claim 2 under 35 U.S.C. § 102 for lack of novelty as evidenced by Christopoulos. The secondary reference to Ejiri does not cure the previously argued deficiencies of Christopoulos. Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite fact-based realistic motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicants, therefore, submit that the imposed rejection of claim 9 under 35 U.S.C. § 103 for obviousness predicated upon Christopoulos in view of Ejiri is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 14, 16 and 21 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Christopoulos in view of Ejiri.

In the statement of the rejection the Examiner made certain determinations as to the teachings of Christopoulos, while admitting Christopoulos does not disclose the concept of controlling the amount of image data in accordance with information concerning the amount of data stored in a buffer or the decoding unit. The Examiner then concluded that one having ordinary skill in the art would have been motivated to modify Christopoulos's system to include control of the received data in accordance with information regarding the amount of data stored in a buffer in view of Ejiri. This rejection is traversed.

Applicants submit that the Examiner's determinations as to the teachings of Ejiri are not accurate. Specifically, Ejiri merely discloses updating quantization parameters in accordance with the buffer occupancy of the smoothing buffers of an encoder. This is far afield from the claimed invention, because Ejiri neither discloses nor suggests the notion of controlling the amount of image data to be received in accordance with the amount of data stored in an input buffer or a decoder, monitoring the amount of data received, and terminating the transmission of the image data when the received apparatus receives a predetermined component of the image data.

The above dramatic difference between the claimed inventions and Ejiri compel the conclusion that even if the applied references are combined as proposed by the Examiner, and again Applicants do not agree that the requisite fact-based realistic motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp., supra.*

Applicants, therefore, submit that the imposed rejection of claims 14, 16 and 21 under 35 U.S.C. § 103 for obviousness predicated upon Christopoulos in view of Ejiri is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 17 and 19 were rejected under 35 U.S.C. § 103 for obviousness predicated upon Christopoulos in view of Enari.

This rejection is traversed. Indeed, this rejection has been rendered moot by canceling claims 17 and 19. Accordingly, withdrawal of the rejection of claims 17 and 19 under 35 U.S.C. § 103 for obviousness predicated upon Christopoulos in view of Enari is solicited.

Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Application No.: 10/077,136

Respectfully submitted,

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